

REMARKS

Claims 1-75 are presented for examination, of which claims 1, 14, 27, 40, 52, and 64 are independent. Claims 76-111 are withdrawn from consideration. Allowance is requested in view of the amendments and following remarks.

Objection to the claims

Claims 1, 14, 27, 40, 52, and 64 were objected to under 35 U.S.C. 132 for allegedly introducing new matter for using the word "profile." This objection is traversed. The term "profile" has been removed from the claims, as amended. Thus, the objection is moot and should be withdrawn.

Rejections of Claims under 35 U.S.C. §§ 102(e), 103(a)

Claims 1-75 are rejected under 35 U.S.C. section 102(e) as allegedly being anticipated by Olivier (U.S. Pat. No. 6,480,885; "Olivier"). This rejection is traversed.

Premature Final Rejection

As an initial matter, the finality of the rejection is premature and should be withdrawn for at least the reason that new grounds for rejection, both in terms of law and in terms of cited references, appear in the January 19, 2005 official action.

In a June 20, 2005 official action claims 5, 18, 31, 44, 56 and 68 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kanevsky et al. (U.S. PG. Pub. 20030088463) as applied to claim 1. However, none of these claims were rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Olivier.

In the January 19, 2005 official action, new grounds for rejection appear as the January official action cites new support for the rejection of these claims. In particular, the January official action 1) rejects the claims under 102(e) instead of 103(a), which amounts to new grounds for rejection in terms of law, and 2) introduces support for the 102 rejection of these claims in Olivier, where such support was not previously relied upon in prior official actions,

which amounts to new grounds for rejection in terms of cited references. Thus, the finality of the rejection should be withdrawn.

Olivier does not Anticipate

In any case, Olivier does not anticipate the claims, as amended, as Olivier does not teach features of the claims.

Olivier discloses storing a recipient list including matching subscribers, filtering the recipient list to match criteria, and distributing a message to matching users. Abstract. Olivier's "preferred embodiment" is limited to searching subscribers of a mailing list, which is a defined recipient list. *See e.g.*, FIG. 2 (message sent to subset of **subscription list** (220) or all in the **subscription list** (238)); FIGS. 5A-5B (matches calculated between **subscribers** (448, 474-488)); FIG. 6 (query to determine **subscriber** matches (496)); FIGS. 8-9 (messages sent to **subscription list** "neighbors@local2me.com"). Other embodiments appear to require a subscription and/or registration for a service. As an example, a website discussed has user profiles and acceptance criteria (which would presumably be based on registration/subscription to a website). col. 25, lines 42-54; col. 26. Similarly, affirmative activity that causes a user to become a member of a defined group and enter criteria from which a match could be made would presumably be required for all the other examples, including gaming between "users," videoconferencing between "users," and the like. See generally col. 22, line 32 to col. 26, line 23.

The claims, as amended, include a feature of performing a search having a scope that "is without regard to an individual's membership to a defined group." See e.g., claim 1. Support for the amendments can be found, in among other sections of the specification, paragraphs 12 and 76, which recite:

"[b]y defining a target group based on one or more attributes rather than explicitly defining the members, the group's membership may vary depending on when the search for members having the attributes is run," and

"[t]he module solves the problem through the creation of distribution lists that are defined by their membership criteria, rather than by their membership. Rather than saving a list of email addresses, the DLM module 70 saves a set of

membership criteria (i.e. rather than store a list of the fifty people who reported to Department X on January 1st, the module saves the criteria "reports to Department X")."

In contrast to the claimed subject matter, Olivier does not disclose a search having a scope that "is without regard to an individual's membership to a defined group" as Olivier is limited to searching subscribers of a service or other users of a service that affirmatively create a membership with a defined group. Claim 1.

The search of Olivier can be limiting because users that are searched for must actively subscribe before they could be searched. Advantageously, the feature of the claimed subject matter directed to having a search scope that "is without regard to an individual's membership to a defined group" may, in some implementations, allow searches to include users who, for example, have not subscribed to any mailing lists or services and who should be included (e.g., new employees who have not actively signed up to subscription lists or registered to be part of a forum). Similarly, in some implementations, users who may have left a company may no longer be included in a dynamic target group with such a scope, whereas, if they were on a subscription list or registered service they might be included if the list has not been updated (e.g., users who have changed jobs or had a life change). As another advantage, subscription lists need not be created and registration need not be had, as data already available in an enterprise can be used (e.g., data available in an enterprise resource planning system). For example, employee profiles in a human resources database can be used. Specification, ¶ 53.

Thus, Olivier does not disclose a feature of the independent claims and the rejection of these claims should be withdrawn.

In addition, Olivier does not disclose "accessing an enterprise resource planning system to identify individuals of the dynamic target group from master data of employees of an enterprise" and such a modification of Olivier would not have made sense. See e.g., claim 5. This feature, or a similar feature, is included in claims 5, 18, 31, 44, 56, and 68. As the nature of Olivier is consumer-oriented (e.g., e-mail for neighborhood, gaming, websites, and the like), not business-oriented (e.g., geared toward an enterprise resource planning system), the application to an enterprise resource planning system and identifying individuals from master data of employees of an enterprise is an unlikely prospect in view of Olivier. Thus, in addition to the

reasons mentioned above with reference to the independent claims, claims 5, 18, 31, 44, 56, and 68 should be allowed for at least these reasons.

Dependent claims 2-4 and 6-13; 15-17 and 19-26; 28-30 and 32-39; 41-43 and 45-51; 53-55 and 57-64; and 65-67 and 69-75 depend, directly or indirectly, on independent claims 1, 14, 27, 40, 52, and 64. Because the independent claims are allowable, these claims are allowable for at least the reasons stated above.

Conclusion

In view of the above amendments and remarks, therefore, all of the claims should be in condition for allowance. A formal notice to that effect is respectfully requested.

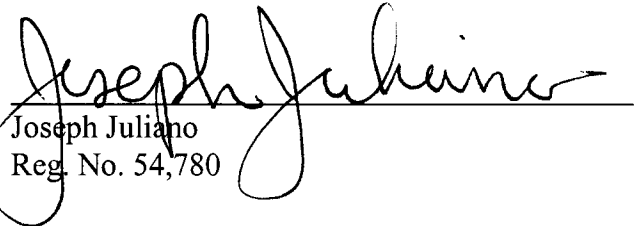
It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicant asks that all claims be allowed. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: _____

6/2/06


Joseph Juliano
Reg. No. 54,780